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| 10/662,913  | 09/15/2003  | Jiann-Chen Chen      | N81438/LPK          | 1253             |
| 1333 7590 07/09/2008<br>EASTMAN KODAK COMPANY<br>PATENT LEGAL STAFF<br>343 STATE STREET<br>ROCHESTER, NY 14650-2201 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| TSOY, ELENA   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1792  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Advisory Action***

The amendment filed on July 2, 2008 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment raises new issues, such as changing the scope of the claims. Note that the limitation "at a temperature of 275<sup>0</sup>C or more" were rejected by the Examiner under 112, first paragraph in the Non-Final Rejection mailed on 10/15/2007. However, Applicants had chosen not to introduce the proposed amendment to overcome 112, first paragraph issues when Applicants had chance to amend the claim 1 as **a matter of right**.

Since the proposed amendment after Final rejection does not merely cancel claims or complies with a formal requirement made earlier, entry of the proposed amendment is denied.

"If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier". See MPEP 706.07 [R-3],

***Response to Arguments***

Applicant's arguments filed July 2, 2008 have been fully considered but they are not persuasive.

**Claim Rejections - 35 U.S.C. § 112**

The Examiner states that curing the topcoat "at a temperature of 275°C or more" is not described in the specification, as the specification includes the statement of curing "up to a temperature of about 275°C or more". While Applicants continue to believe that the claim as previously presented is adequately enabled for the reasons set forth in the previous response,

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claim 1 has been amended to delete such temperature recitation to moot such issue and advance this application to issuance. As the claim amendment merely reinstates the original claim language with respect to curing of the topcoat (which language was not rejected under 35 USC 112), no new issues are raised that would require further search and consideration. Entry of such amendment after final, and allowance of the claims, is accordingly respectfully requested. Alternatively, entry of this amendment is respectfully requested to minimize any remaining issues for appeal, and thus place the application in better form for appeal.

The Examiner respectfully disagrees with this argument for the reasons discussed above.

Moreover, since Applicants did not "merely reinstate the original claim" after Non-Final Rejection when Applicants had chance to amend the claim 1 as **a matter of right**, entry of the proposed amendment is denied.

#### **Claim Rejections - 35 U.S.C. § 103**

The Examiner states that the fact that the preamble of the Jepson format claim of original claim 19 is Declarants' own work is insufficient to overcome the rejection of the claims based on the cited prior art because the limitations of the preamble were well known in the art, as evidenced by the Hartley et al and Chen et al references, as explained in the paragraph 7 of the Office action mailed 10/10/2006. Such statement, however, is inconsistent with the stated grounds of rejection actually set forth in the Final Rejection, as such "admitted" prior art is still relied upon in all stated grounds of rejection. Further all stated grounds of rejection do not rely on Hartley et al and Chen et al., and such statement by the Examiner is thus not clear as to the status of all the rejections. Additionally, such Hartley et al and Chen et al references in any event do not disclose all limitations of the preamble of original claim 19 (e.g., there is no disclosure in such references of a method of producing a replaceable fuser member adapted to be positioned on a machine mandrel in a fuser system, wherein a sleeve is mounted on a mandrel configured to receive the sleeve over the outside of the mandrel). Accordingly, it is respectfully submitted that to the extent all stated grounds of rejection under 35 USC 103 continue to rely on alleged "admitted" prior art, such rejections are clearly improper and should be removed.

The Examiner respectfully disagrees with this argument. As explained in the paragraph 7 of the Office action mailed 10/10/2006, the Examiner relied on Applicants' admission (ASA) that the current invention is directed to improvements in the fabrication process of replaceable fuser members for fuser rollers in electrophotographic applications whereby good adhesion is provided between the layers of cured material including the member and whereby increased ease of installation and reduced replacement (See specification, page 4, lines 8-15). In other words, the only Applicants' admission that Examiner relied upon is that the fabrication process of replaceable fuser members for fuser rollers in electrophotographic applications (i.e. a method of producing a replaceable fuser member adapted to be positioned on a machine mandrel in a fuser system, wherein a sleeve is mounted on a mandrel configured to receive the sleeve over the

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outside of the mandrel) was known in the art; and *all* claimed improvements were shown by Hartley et al and Chen et al references. Therefore, ASA in combination with Hartley et al and Chen et al references show *all* limitations of claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.  
Primary Examiner  
Art Unit 1792

July 12, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792